

REMARKS/ARGUMENTS

Claims 1, 3-9, and 11-15 are currently pending. Applicant acknowledges receipt of the above-referenced Office Action and respectfully traverses the substantive portions thereof in their entirety. Applicant respectfully reserves the right to pursue one or more additional patent applications directed to the previously pending claims or

REJECTIONS UNDER 35 U.S.C. §101

Claims 1, 3-8 stand rejected under 35 U.S.C. §101. In making the rejection, it was asserted that the claims do not recite a series of steps or acts which are either 1) tied to a particular machine, or 2) transform the underlying subject matter to a different state or thing (i.e., the “machine or transformation test”). Applicant respectfully traverses. Claim 1 clearly recites a computer readable media having tangibly stored thereon instructions which, when executed by a processor, cause a processor to perform a series of tasks or instructions. The claims clearly tie instructions to a particular processor/machine, thereby satisfying the first part of the machine or transformation test. In addition, the instructions that are tangibly stored on the computer readable media are read by the processor and cause the processor to perform different steps. At the very least, the contents of the various internal registers in the processor changes as a result of each such step, therefore the processor is transformed to a different state. Therefore, Applicant’s claims satisfy the second prong of the machine or transformation test as well.

REJECTIONS UNDER 35 U.S.C. §103

Claim 1-3, 7-9, 11, and 15-17 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,086,618 to Al-Hilali et al. (“Al-Hilali”) and further in view of U.S. Patent No. 6,056,786 to Rivera et al. (“Rivera”). Applicant respectfully traverses. The independent claims were previously amended to focus on the fact that the count of the total number of transactions that have not finished execution within a given time interval is collected and used to improve the estimate of the number of transaction executed during a given time interval. In the previous Office Action, it was conceded that Al-Hilali does not teach this limitation, and Applicant agrees. On page 5 of the instant Office Action, it is asserted that page 7, lines 8-14 of Rivera, discloses this limitation. As the specification comprises only 6 pages of text, Applicant’s undersigned representative assumes the Examiner was intending to refer to column 7, lines 8-14, and respectfully reserves the right to amend and/or withdraw some or all of the arguments

presented herein should such assumption be incorrect. With respect to the underlying rejection, Applicant respectfully traverses.

First, Applicant's undersigned representative respectfully asserts that Rivera is so far afield from Applicant's claimed invention and/or that of Al-Hilali that one skilled in the art would not be motivated to look to Rivera. Al-Hilali discloses a method for developing system resource usage "cost" equations, creating models based upon such cost equations, and estimating total system resource usage. (Abstract). By contrast, Rivera discloses a technique for monitoring license compliance for client-server software. (Title). Applicant respectfully suggests that one skilled in the art of estimating system resource usage would not be motivated to look to systems for monitoring license compliance, as such endeavors are not analogous or even related art. Applicant's undersigned representative therefore asserts that the rejection is based on an improper combination of non-analogous art, and the rejection should be withdrawn.

Second, assuming, without admitting, that a) the combination of Rivera and Al-Hilali were somehow proper, and b) that Rivera discloses the limitation for which the Examiner cites it, Applicant's undersigned representative respectfully asserts that, absent the hindsight gained from Applicant's invention, one skilled in the art would not be motivated to modify Al-Hilali to achieve Applicant's invention. In issuing the rejection, the Examiner has failed to describe a teaching, suggestion, motivation, or other such reasoning through which one skilled in the art would be motivated to modify Al-Hilali, other than that which is provided in Applicant's own specification and claims. Furthermore, a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. KSR Int'l Co. v. Teleflex, 127 S.Ct 1727, 1741 (2007). As former Chief Judge Markey of the Federal Circuit has stated, "virtually all inventions are 'combinations', and ... every invention is formed of 'old elements' Only God works from nothing. Man must work with old elements." H.T. Markey, *Why Not the Statute?* 65 J. Pat. Off. Soc'y 331, 333-334 (1983). The factfinder should be aware of the distortion caused by hindsight bias and must be cautious of arguments reliant upon ex post reasoning. KSR Int'l Co. v. Teleflex, 127 S.Ct at 1742. In determining whether a claimed invention is an obvious combination of prior art references, it must be shown there is an apparent reason to combine the known elements in the fashion claimed. Id. at 1741. To facilitate review, this analysis should be made explicit. Id. It is respectfully asserted that, absent such a *prima facie* showing, the combination must be assumed

to be based on hindsight. The Examiner has not advanced a sufficient rationale as to why a person skilled in the art would have been motivated to combine Al-Hilali and Rivera in the manner described in the present Office Action.

Third, even assuming, without admitting, that 1) the combination of Rivera and Al-Hilali were somehow proper and 2) that the current rejection were not based on hindsight, Applicant's undersigned representative respectfully asserts that Rivera fails to teach or suggest the limitation for which it is cited. More specifically, Applicant's claim recites, in pertinent part, "obtaining further transaction count data, the further transaction count data comprising additional information relating to the execution time of a transaction and a count of the total number of transactions that have not finished execution within a given time interval". The current Office Action asserts that page 7, lines 8-14, and figure 5 disclose this limitation. It is assumed for the purposes of the instant Response that the Examiner was referring to column 7 and Figure 5A. As Rivera states, Figure 5A illustrates logic involved in determining the number of users or client computers transacting with a server program (Col. 4, lines 46-50). The transactions described in Rivera are not "executing", as recited in Applicant's claims. Therefore, Figure 5A clearly cannot illustrate obtaining information relating to the execution time of a transaction or a count of the total number of transactions that have not finished execution within a time interval. Similarly, column 7 lines 8-14 discloses monitoring the number of computers which concurrently access a particular program during a particular time period. Applicant's undersigned representative respectfully asserts that Rivera clearly fails to teach or suggest obtaining further transaction count data...[including] a count of the total number of transactions that have not finished execution within a given time period.

Fourth, even assuming, without admitting, that all of the other faults with Al-Hilali, Rivera, and the combinations thereof were somehow not present, it is respectfully submitted that Rivera teaches away from Applicant's claimed invention. Column 7 lines 8-20 disclose licensing programs on computers, and more specifically that when a program is licensed on a per computer basis "the relevant criteria is the total number of unique computers which access the server program, a broad time period, such as an entire day, would be more appropriate and there would be no need to divide the period into intervals". By contrast, Applicant's claimed invention clearly recites determining the total number of transactions that have not finished execution within a given time interval", which clearly requires dividing a period into intervals.

RESPONSE

Examiner: **HENRY, Mariegeorges A**

Serial No.: 10/540,909

Atty. Docket No.: **602-L**

Applicant respectfully asserts that the currently pending claims are patentable as neither Al-Hilali nor Rivera, either alone or in combination, teaches or suggests all elements recited in Applicant's claims.

CONCLUSION

Having responded to all objections and rejections set forth in the outstanding Office Action, it is submitted that the currently pending claims are in condition for allowance and Notice to that effect is respectfully solicited. Additional characteristics or arguments may exist that distinguish the claims over the prior art cited by the Examiner, and Applicants respectfully preserve their right to present these in the future, should they be necessary. In the event that the Examiner is of the opinion that a brief telephone or personal interview will facilitate allowance of one or more of the above claims, he is courteously requested to contact applicant's undersigned representative.

AUTHORIZATION

The Commissioner is authorized to charge any additional fees associated with this filing, and credit any overpayment, to Deposit Account No. 19-3790. If an extension of time is required, this should be considered a petition therefor. If the fees associated with a Request for Continued Examination are filed herewith, this should be considered a petition therefor.

Respectfully submitted,

/ James E. Goepel /

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